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OFFICE OF PETITIONS

In re Application of
Scott Wilber
Application No. 09/699,523
Filed: October 30, 2000
Attorney Docket No. 2022/002D1

:
: DECISION ON
: APPLICATION FOR
: PATENT TERM ADJUSTMENT
:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE UNDER RULES 1.702(a)(2) AND 1.705(b)," filed January 8, 2004. Applicant requests that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to one hundred fifty-four (154) days. For the reasons set forth herein, the paper has also been treated as a request to withdraw the holding of abandonment.

The application for patent term adjustment is GRANTED.

The petition to withdraw the holding of abandonment is also GRANTED.

On October 15, 2003, the Office accepted applicant's response to the non-final Office action mailed March 28, 2003. This response was accompanied by a showing pursuant to § 1.8(b) that the response should be treated as timely filed by facsimile on April 9, 2003. Because the record lacks a showing acted on by the Office of previous timely filing of the response¹, and since the response of record was received on October 15, 2003, outside of the period for reply to the non-final Office action, the application appears to have become abandoned for failure to file a timely reply. This holding of abandonment is withdrawn, however, in view of the showing of record of the response's timely filing.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one hundred fifty-four (154) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On December 29, 2003, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-

¹ Applicants filed a paper October 15, 2003 to show timely filing; however, it does not appear that the Office acted on this paper by responding with a decision withdrawing any holding of abandonment.

identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. On January 8, 2003, applicant timely submitted the instant request for reconsideration of the patent term adjustment². At the time of the mailing of the notice of allowance, the term of the patent was adjusted by 12 days for the Office's delay in mailing a first Office action under 35 U.S.C. 132. See § 1.703(a)(1). However, the adjustment was reduced by 109 days for applicant's late response received October 15, 2003, to the non-final Office action mailed March 28, 2003. Applicants dispute this reduction, asserting that the response was filed on April 9, 2003 in compliance with § 1.704(b). Moreover, given the April 9, 2003 date of this response, applicants contend entitlement to an adjustment of 142 days for the delay from August 10, 2003, the day after the date that is four months after the date a reply under § 1.111 was filed, to December 29, 2003, the date of mailing of the notice of allowance. See § 1.703(a)(2).

As discussed above, the response has been shown to have been filed on April 9, 2003, not October 15, 2003. The response was timely filed within three months of the mailing of the Office action on March 28, 2003 in compliance with § 1.704(b). See 1.704(b). Accordingly, the patent term adjustment should not have been reduced by 109 days.

Further, as stated by applicants, the patent issuing from this application is entitled to an additional adjustment of 142 days for Office delay in taking action in response to applicant's response shown to have been received in the Office on April 9, 2003.

In view thereof, the patent term adjustment at the time of the mailing of the Notice of Allowance should have been one hundred fifty-four (154) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for timely issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Petitions Attorney, at (703) 305-0309.

Karin A. Ferriter
for

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen

² Palm records indicate that the Issue Fee payment was also received in the Office on January 8, 2003.